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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,209	09/09/2003	Toshiyuki Noguchi	00862.023227.	9145
5514	7590	08/07/2008		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
			EXAMINER	
			PATEL, MANGLESH M	
			ART UNIT	PAPER NUMBER
			2178	
			MAIL DATE	DELIVERY MODE
			08/07/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/657,209	NOGUCHI, TOSHIYUKI	
	<b>Examiner</b>	<b>Art Unit</b>	
	MANGLESH M. PATEL	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 April 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 16,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 16,20 and 21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

**DETAILED ACTION**

1. This FINAL action is responsive to the amendment filed 4/9/2008.
2. Claims 16 and 20-21 are pending. Claims 18 and 22 have been canceled. Claims 16, 20 and 21 are the independent claims.

**Withdrawn Rejections**

3. The 35 U.S.C. 103(a) rejections of claims 16, 18 and 20-22 with cited references of Ohta (U.S. 6, 980, 319) in view of Lin (U.S. 6,757,070) has been withdrawn in light of the amendment.

**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 16 and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohta (U.S. 6, 980, 319, filed on Mar 2, 2001).

**Regarding Independent claims 16, 20 and 21,** Ohta discloses a communication apparatus, that communicates with an information providing apparatus via a network and connects to a plurality of printers comprising (see fig 3-4 & column 2, lines 15-67, wherein a communication apparatus such as a portable digital device communicates with the print server via a network and connects to a plurality of print stations): a download unit configured to download the image data to be printed by the connected printers from said information providing apparatus (see column 5, lines 15-20 which states “In response to the print command, the generated document is initially transferred to the print server...”, thereby being stored on information providing apparatus and then being sent to the print stations (see column 4, lines 60-67). a storage unit configured to store a plurality of printer driver programs each of which respectively corresponds to each of the connected printers (column 7, lines 40-50, which describes that the disk unit stores printer device drivers); a reception unit configured to receive, from said information providing apparatus, a recommended printing condition list which includes at least one of the models of printers, paper sizes, types of paper and layout as a printing condition of

printing the downloaded image data (column 22, lines 25-67, wherein a reception unit of a mobile device is configured to receive from the internet via a web server a set of printing characteristics that includes paper size). an acquisition unit configured to acquire printable condition information concerning the connected printers from the plurality of printer driver programs stored in said storage unit (see column 18, lines 35-45 & column 22, lines 25-67, wherein in either scenario the print server or the mobile device acquires the printer characteristics concerning the connected print stations which includes the print drivers described in column 2, lines 15-67); a list extraction unit configured to extract a printing condition selection list from the recommended printing condition list received by said reception unit, on the basis of the printable condition information acquired by said acquisition unit (column 18, lines 35-45 & column 22, lines 25-67); a condition selection unit configured to select a printing condition from the printing condition selection list extracted by said list extraction unit (column 18, lines 35-45 & column 22, lines 25-67, wherein the selection is determined by either the print server or the mobile device); and a generation unit configured to generate print data from the image data downloaded by said download unit, on the basis of the printing condition selected by said condition selection unit, by using one of the plurality of printer driver programs in said storage unit (column 18, lines 35-45, wherein the print server including the downloaded document data generates print data as a print job based on the print characteristics of the devices using the drivers described in column 2, lines 15-67).

*It is noted that any citation [[s]] to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.*  
[[See, MPEP 2123]]

#### **Response to Arguments**

6. Applicant's arguments filed 4/9/2008 have been fully considered but are moot in view of the new grounds of rejection. However the portions argued against the Ohta reference will be addressed below.

Applicant argues: The applied art is not seen to disclose or suggest the features of the present invention, and in particular is not seen to disclose or suggest at least the features of (i) receiving a recommending printing condition list from an information providing apparatus as a printing condition of the printing downloaded image data, and (ii) extracting a printing condition selection list from the recommended printing condition list, on the basis of the printable condition information acquired from a plurality of printer driver programs (pg 8, paragraph 3 – page 9, paragraph 1)

Applicant Argues: However, Ohta is seen simply to disclose print stations sending information regarding their print characteristics to a print server, rather than receiving a recommended printing condition list from an information providing apparatus. (pg 9. paragraph 3)

The Examiner Respectfully disagrees: Ohta discusses several embodiments that include receiving a recommended printing condition list as printer characteristics recommended by the printer to the web based server via the internet shown in fig 17B and then being sent to the client device 14 as discussed in column 22, lines 25-67. Further Ohta shows extracting a printing condition selection list or specifying the appropriate printer based on the print characteristics using the drivers disclosed in column 7, lines 40-50.

It is not necessary that the references actually suggest, expressly or in so many words the changes or improvements that applicant has made. The test for combining references is what the references as a whole would have suggested to one of ordinary skill in the art. In re Scheckler, 168 USPQ 716 (CCPA 1971); In re McLaughlin 170 USPQ 209 (CCPA 1971); In re Young 159 USPQ 725 (CCPA 1968).

### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M,F 8:30-6:00 T,TH 8:30-3:00 Wed 8:30-7:00.

Art Unit: 2178

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571)272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manglesh M. Patel  
Patent Examiner (AU 2178)  
July 30, 2008

/Manglesh M Patel/  
Manglesh Patel  
Examiner, Art Unit 2178

	/CESAR B PAULA/  Primary Examiner, Art Unit 2178
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